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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,900	06/26/2001	Kai H. Chang	2-8-23	2416

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/891,900	<b>Applicant(s)</b> CHANG ET AL.	
	<b>Examiner</b> John Hoffmann	<b>Art Unit</b> 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
     4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of Group I in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 21 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite for numerous reasons. Below are a few examples. This is NOT an exhaustive list. The burden is on Applicant to find and **correct all language** that is indefinite.

Claim 1: Line 8: there is no antecedent basis for "the partial pressure of oxygen" and that makes it confusing as to whether there must be oxygen. Line 10: there is no

antecedent basis for "the optical fiber preform" - it is unclear how this differs from the rod.

From MPEP 2173.05(h):

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

Presently, claim 1, step b has a group which is very similar to the above accepted form, but there is no indication that the group is "consisting of" the members. Therefore it is impossible for anyone to tell if applicant's group is open or closed to additional members - and thus the claim presents uncertainty or ambiguity with respect to the question of scope of the claim. If the above "acceptable form" is not desirable for Applicant, Examiner can be telephoned for other expressions.

Claim 2: line 2: it is unclear if the preform is the same preform as that of claim 1, or a different preform. Line 3: it is unclear if the drawing step refers to the first drawing, or if it must apply to the repeated drawing.

Claim 6: the relevance of [RIT overclad] is not understood. The claim calls for a "further" overcladding. The claim 2 overcladding creates the "overclad optical fiber preform". However claim 6 requires the tube collapse creates this preform. Only one or the other can create the preform - it is unclear which.

Claim 16 - 2<sup>nd</sup> to last line: there is no antecedent basis for "the change". It is unclear how long thereafter the change is less than 0.0dB/km.

AGAIN, the above is not an exhaustive list, Applicant is REQUIRED to present definite claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blankenship 5059229.

Step (a) see figure 7 of Blankenship.

Step (b): see col. 7, lines 24-27 which has no partial pressure of oxygen. The claim does not require that there be any oxygen. It is deemed that the broadest reasonable interpretation of the oxygen partial pressure is essentially: if there is an oxygen partial pressure, then it is controllable. Blankenship has no such partial pressure.

Step c) : see col. 7, lines 29-31.

Step D) : see col. 8, lines 6-13.

Step E) : see col. 8, lines 14-19 and 47.

Step F): see col. 8, lines 38-65 – it is inherent or obvious that these losses were measured.

Step g): it is deemed that the broadest reasonable interpretation of the claim is such that step g) is relevant only when there is a partial pressure of Oxygen – and not relevant when there is no such partial pressure. One cannot change a partial pressure when it does not exist.

Step H): it would have been obvious to repeat the process as many times as desired – depending upon how much fiber is desired.

Claims 2-3, 5: see the paragraph bridging cols. 7-8.

Claims 4 is met for the same reason step H) is met above: Blankenship has no oxygen partial pressure and the claim only limits methods with partial pressures.

Claim 7: See col. 8, lines 60-65. 79 hours is approximately 4 days.

Claims 8-15 are either clearly met – or are met because they are substantially the same as the claims above.

Claim 16: is met for the same reason claim 1 is, namely the claim is constructed with such breadth that the partial pressure requirement is only germane to methods that have an oxygen partial pressure and do not limit methods that lack such. Alternatively: It would have been obvious to have the losses as low as possible and to have as low as change in loss as possible because loss is a bad thing. It is noted that if Applicant presents any evidence or argument that one of ordinary skill would not know how to get the claimed loss level, then it is likely that such evidence or argument might be used in an non-enablement or scope of enablement rejection. Presently it is deemed that the

invention is fully enabled and one of ordinary skill would know how to get the loss levels presently claimed.

Claims 17-20 are similarly met.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blankenship 5059229 as applied to claim 1 above, and further in view of Fleming 5364427.

Blankenship teaches the invention except for the overlaid tube. It is well known to save time and money by applying cladding via an overlaid tube – as opposed to other methods of forming a cladding. It would have been obvious to produce the Blankenship preform by using a cladding tube to provide the outer layer so as to reduce the cost. Fleming is cited as evidence that there is “significant cost saving” by using an overlaid tube (see Fleming col. 1, lines 13-33).

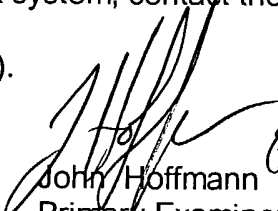
### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miller 4708726, Powers 4165223, Kuisl 4564378 and Kyoto 4812155 and 4902325 are cited as evidence that it is known to have a partial pressure of oxygen when drying soot preforms. Antos is cited as being relevant to the disclosed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 8-31-04  
John Hoffmann  
Primary Examiner  
Art Unit 1731

jmh